

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 23, 2005 (Paper No. 20050518). Upon entry of this response, claims 1-19 are pending in the application. In this response, claims 1, 7, and 15 have been amended. Applicant respectfully requests that there be reconsideration of all pending claims.

1. **Examiner Interview**

A telephone interview between the Examiner and Applicant's representatives (Jeff Kuester and Karen Hazzah) took place on June 6, 2005. During the interview, U.S. Patent No. 6,009,462 to *Birrell et al.* (*Birrell* '462) was discussed with reference to independent claims 1 and 7. Applicant's representatives explained some of the differences between claims 1 and 7 and *Birrell* '462, and the Examiner suggested potential claiming strategies to express these differences. Applicant wishes to thank the Examiner for his time.

2. **Rejection of Claims 1, 2, 4, 5, 7, 9, and 15-17 under 35 U.S.C. §102**

Claims 1, 2, 4, 5, 7, 9, and 15-17 have been rejected under §102(e) as allegedly anticipated by *Birrell et al.* (U.S. 6,009,462), hereinafter *Birrell* '462. Applicant respectfully submits that the rejection of claims 1, 2, 4, 5, 7, 9, and 15-17 has been overcome. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

A. **Claim 1**

Applicant respectfully submits that *Birrell* '462 fails to teach, disclose or suggest at least "responsive to the e-mail server receiving the e-mail communication containing the attachment

file, the e-mail server searching a database of attachment files that were attached to previously-received e-mail communications for a copy of the attachment file from the received e-mail communication” as recited in amended claim 1.

Birrell ‘462 discloses a system 200 in which “mail messages are accessed by using queries.” (Col. 5, lines 54-55.) “By specifying the name of a query, a user can easily retrieve messages related to a particular topic, phrase, date, sender, etc.” (Col. 5, lines 57-61.) The query in *Birrell* ‘462 is responsive to a user action. In contrast, amended claim 1 recites an e-mail server performing a search “responsive to the e-mail server receiving the e-mail communication containing the attachment file.” Thus, even if the user-initiated query described in *Birrell* ‘462 is performed by the server, the query is *not* performed responsive to receipt of an e-mail communication containing an attachment file, as recited in amended claim 1.

For at least the reason that *Birrell* ‘462 fails to disclose, teach, or suggest this feature, Applicant respectfully submits that amended claim 1 overcomes the rejection. Therefore, Applicant requests that the rejection of claim 1 be withdrawn.

B. Claim 7

Applicant respectfully submits that *Birrell* ‘462 fails to teach, disclose or suggest at least “responsive to the e-mail server receiving an e-mail communication containing an attachment file, the e-mail server extracting header information from the e-mail communication and storing the e-mail header information in a mail store,” as recited in amended claim 7.

Birrell ‘462 discloses that a user can create a query that “searches for messages that match on words and labels specified in the query.” (Col. 9, lines 40-45.) *Birrell* ‘462 further discloses that the query can search for words in a field in a message header. (Col. 9, lines 55-60). However, *Birrell* ‘462 does not disclose that the query involves “the e-mail server *extracting*

header information from the e-mail communication” as recited in claim 7. Furthermore, even if the query in *Birrell* ‘462 did include extracting header information, the query is performed in response to a user action, and *not* “responsive to the e-mail server receiving an e-mail communication containing an attachment file, as recited in amended claim 7.

For at least the reason that *Birrell* ‘462 fails to disclose, teach, or suggest this feature, Applicant respectfully submits that amended claim 7 overcomes the rejection. Therefore, Applicant requests that the rejection of claim 7 be withdrawn.

C. Claim 15

Applicant respectfully submits that *Birrell* ‘462 fails to teach, disclose or suggest at least “e-mail attachment file checking software for determining, responsive to the MTA server receiving an e-mail communication containing an attachment file, whether the attachment file in the received e-mail communication is a duplicate of an attachment file that was attached to previously-received e-mail communications in the mail store” as recited in amended claim 15.

Birrell ‘462 discloses a system 200 in which “mail messages are accessed by using queries.” (Col. 5, lines 54-55.) “By specifying the name of a query, a user can easily retrieve messages related to a particular topic, phrase, date, sender, etc.” (Col. 5, lines 57-61.) The query in *Birrell* ‘462 is responsive to a user action. In contrast, amended claim 15 is directed to an e-mail server including “e-mail attachment file checking software” which makes a determination “responsive to the MTA server receiving an e-mail communication containing an attachment file.” Thus, even if the query in *Birrell* ‘462 corresponds to the determination made by the e-mail attachment file checking software recited in amended claim 15, the query is performed in response to a user action and not “responsive to the MTA server receiving an e-mail communication containing an attachment file.”

For at least the reason that *Birrell* '462 fails to disclose, teach, or suggest this feature, Applicant respectfully submits that amended claim 15 overcomes the rejection. Therefore, Applicant requests that the rejection of claim 15 be withdrawn.

D. Claims 2, 4, 6, 9, 16, and 17

Since claims 1, 7, and 15 are allowable, Applicant respectfully submits that claims 2, 4, 6, 9, 16, and 17 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2, 4, 6, 9, 16, and 17 be withdrawn.

3. Rejection of Claims 3, 5, 8, 10-14, 18, and 19 under 35 U.S.C. §103

Claims 3, 5, 8, 10-14, 18, and 19 have been rejected under §103(a) as allegedly being obvious over *Birrell et al.* (U.S. 6,009,462) in view of *Geiger et al.* (U.S. 6,073,142). Applicant respectfully traverses this rejection. Since claims 1, 7, and 15 are allowable, Applicant respectfully submits that claims 3, 5, 8, 10-14, 18, and 19 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 3, 5, 8, 10-14, 18, and 19 be withdrawn.

4. Miscellaneous Findings

A. Inherency

Applicant respectfully traverses the finding in the Office Action that the following feature is an inherent feature of database searching: "the database of attachment files is searched by performing a checksum against the attachment file of the received e-mail message communication." (Office Action, p. 3, paragraph 5.) This feature is not necessarily present in a

database system. For example, a search could hypothetically be performed by a byte-wise comparison instead of a checksum comparison. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicant traverses that finding as being inadequate to show why the claimed feature is “necessarily present” in the reference. Consequently, because of the lack of extrinsic evidence required under *In re Robertson*, the Office Action’s statement is merely conclusory and not adequately supported, and the rejection of claim 5 should be withdrawn.

B. Well-known

Applicant respectfully traverses the following finding in the Office Action:

It was well-known in the email art that a email message could be analyzed based on the POP rules and properties as taught by Geiger [Geiger, the gatekeeping Post office and business rules, abstract; monitor email message, col 3, lines 1-19; various properties, size attachment, col 13, lines 35-40].
(Office Action, p. 6, paragraph 11).

Applicant respectfully submits that the subject matter should not be considered well-known to one of ordinary skill in the art, because the Office Action did not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusion. Such specific findings and reasoning are required by MPEP § 2144.03.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-19 be allowed to issue. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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